

REMARKS

In an Office Action dated March 13, 2003, for the parent case (U.S. Application 10/188,455), Claims 2-9, 11-21, 23-31, 33-35, 37, and 39 were objected to based on informalities. Claims 22-24 and 36-39 were rejected under 35 U.S.C. § 102(b), as being unpatentable over Scott (U.S. Patent 5,523,551). Claim 35 was rejected under 35 U.S.C. § 103(a), as being unpatentable over Scott in view of Lancos, et al. (Published U.S. Application 2002/0074398). Claims 1-21 were allowed.

Applicants have amended the claims, but no new matter has been added by this Amendment. Specifically, Applicants have cancelled Claims 1-21, which were allowed in the parent case. Applicants now pursue Claims 22-39, which were cancelled in the parent case to expedite the issuance of the parent case for Claims 1-21. In view of the following remarks, Applicants respectfully request a notice of allowance for the current application.

Objections to Claims 2-9, 11-21, 23-31, 33-35, 37, and 39

Applicants have amended Claims 23-31, 33-35, 37, and 39 to comply with the claim objections in the prior Office Action in the parent case. Claims 1-21 have been cancelled. Thus, Applicants respectfully submit that there should be no further objections to Claims 2-9, 11-21, 23-31, 33-35, 37, and 39.

Rejections under 35 U.S.C. § 102(b)

Claims 22-34 and 36-39 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,523,551 to Scott ("Scott"). The MPEP states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (8th ed., rev. 1, 2003).

Claims 22-31

Claim 22 is an independent claim, and Claims 23-31 depend therefrom. Claim 22 requires:

A method for allowing a customer to either purchase or rent a video on an optically readable medium, the method comprising:
receiving a request for the video;
receiving payment information;
at a point of sale, writing video content on the optically readable medium;
at the point of sale, writing sales information on the optically readable medium; and
at the point of sale, providing the video on the optically readable medium to the customer.

Applicants have carefully reviewed Scott, including the portions of Scott cited by the Examiner, and are unable to find support for the prior Office Action's assertion that Scott discloses all of the elements of Claim 22. For example, Claim 22 requires a step of: "at the point of sale, writing video content on the optically readable medium." The prior Office Action asserted that Scott discloses this "through a magnetic write head" at "col. 2, lines 1-9 and col. 5 lines 5, lines 28+." However, Scott does not disclose writing video content on an optically readable medium at the point of sale. Thus, Claim 22 is not anticipated by Scott. Because Claims 23-31 depend from Claim 22, Claims 23-31 are also not anticipated by Scott for at least the same reason.

Claims 32-34

Claim 32 is an independent claim, and Claims 33 and 34 depend therefrom. Claim 32 requires:

A method of providing digital content to a customer, the method comprising:
receiving a request from the customer, the request including an indication of digital content and a point of sale;
receiving payment information;
at the point of sale, writing the digital content on a readable medium;
at the point of sale, writing sales information on the medium, the sales information including timing information corresponding to the time and date of providing the digital content on the medium to the customer, the sales information also including the payment information;
at the point of sale, providing the medium to the customer;
receiving the medium from the customer; and
providing the customer with a payment credit, the payment credit being determined at least in part by the sales information.

Scott does not disclose writing customer-requested digital content on a readable medium at the point of sale and providing this digital content to the customer. Thus, Claim 32 is not

anticipated by Scott. Because Claims 33 and 34 depend from Claim 32, Claims 33 and 34 are also not anticipated by Scott for at least the same reason.

Claims 36 and 37

Claim 36 is an independent claim, and Claim 37 depends therefrom. Claim 36 requires:

An apparatus allowing a customer to either purchase or rent a video on an optically readable medium, the apparatus comprising:
a housing;
means for receiving a request for the video, the means for receiving a request being disposed within the housing;
means for receiving payment information, the means for receiving payment information being disposed within the housing;
means for writing video content on the optically readable medium, the means for writing video content being disposed within the housing;
means for writing sales information on the optically readable medium, the means for writing sales information being disposed within the housing; and
means for providing the video on the optically readable medium to the customer, the means for providing being disposed within the housing.

Applicants have carefully reviewed Scott, including the portions of Scott cited by the Examiner, and are unable to find support for the prior Office Action's assertion that Scott discloses all of the elements of Claim 36. For example, Claim 36 requires "means for writing video content on the optically readable medium, the means for writing video content being disposed within the housing." The prior Office Action asserted that Scott discloses this "through a magnetic write head" at "col. 2, lines 1-9 and col. 5 lines 5, lines 28+." However, Scott does not disclose writing video content on an optically readable medium within the housing. Thus, Claim 36 is not anticipated by Scott. Because Claim 37 depends from Claim 36, Claim 37 is also not anticipated by Scott for at least the same reason.

Claims 38 and 39

Claim 38 is an independent claim, and Claim 39 depends therefrom. Claim 38 requires:

A method for allowing a customer to either purchase or rent entertainment content on an optically readable medium, the method comprising:
receiving a request for the entertainment content;
receiving payment information;

writing entertainment content on the optically readable medium at a point of sale;
writing time and date information on the optically readable medium at the point of sale;
providing the entertainment content on the optically readable medium to the customer at the point of sale; and
providing the customer with a partial payment credit if the customer returns the entertainment content on the optically readable medium to the point of sale.

Applicants have carefully reviewed Scott, including the portions of Scott cited by the Examiner, and are unable to find support for the prior Office Action's assertion that Scott discloses all of the elements of Claim 36. For example, Claim 36 requires a step of "writing entertainment content on the optically readable medium at a point of sale." The prior Office Action asserted that Scott discloses this "through a magnetic write head" at "col. 2, lines 1-9 and col. 5 lines 5, lines 28+." However, Scott does not disclose writing entertainment content on an optically readable medium at a point of sale. Thus, Claim 38 is not anticipated by Scott. Because Claim 39 depends from Claim 38, Claim 39 is also not anticipated by Scott for at least the same reason.

Accordingly, Applicants respectfully submit that there should be no rejection of Claims 22-34 and 36-39 under 35 U.S.C. § 102(b) in light of Scott.

Rejection of Claim 35 under 35 U.S.C. § 103(a)

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,523,551 to Scott ("Scott") in view of U.S. Patent Application Publication US2002/0074398 to Lancos, et al. ("Lancos"). Regarding obviousness, MPEP 2143 (8th ed., rev. 1, 2003) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 35 depends from Claim 32, and further recites, "wherein the medium comprises a digital versatile disc." Applicants agree with the prior Office Action's statement that "Scott fails to teach a method, wherein the optically readable medium is a digital versatile disc." Applicants

further assert that Scott does not disclose, teach, suggest, nor motivate the writing of customer-requested digital content on a digital versatile disc (DVD) at the point of sale and providing this DVD containing the customer-requested digital content thereon to the customer, as Claim 35 requires.

The prior Office Action asserted that Lancos “discloses a kiosk, which includes an optically readable medium such as a digital versatile disc (page 4; paragraph 0044, lines 5+).” But, Applicants have carefully reviewed Lancos in its entirety. Lancos does not disclose, teach, suggest, nor motivate the writing of customer-requested digital content on a DVD at the point of sale and providing this DVD containing the customer-requested digital content thereon to the customer, as Claim 35 requires. Therefore, Claim 35 is not obvious over Scott in view of Lancos.


CONCLUSION

In view of the foregoing amendments and remarks, this application is in condition for allowance. Therefore, Applicants respectfully request an early reconsideration and a notice of allowance. If the Examiner should have any questions or feel that a discussion would advance the prosecution, Applicants invite the Examiner to contact Applicants’ attorney at the telephone number listed below.

Respectfully submitted,

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